

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Davis et al

Art Unit 3688

Application No.: 09/697,009

Filed: October 25, 2000

Confirmation No. 4530

For: DIGITALLY MARKED OBJECTS AND  
PROMOTIONAL METHODS

Examiner: J. Janvier

VIA ELECTRONIC FILING

Date: December 7, 2009

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COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO ANSWERS FILED SEPTEMBER 16 AND OCTOBER 6**

Sir:

This case has had a somewhat difficult history. A review may be useful.

A Final Rejection was mailed January 31, 2005.

Appellants appealed on May 2, 2005, and filed an Appeal Brief on November 5, 2005.<sup>1</sup> In response to a notice of non-compliance, appellants filed a substitute Appeal Brief on March 16, 2006.

The Examiner filed an Answer on May 24, 2006.

Appellants responded with a Reply Brief on July 17, 2006 – raising a number of new issues in objection to the Answer.

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<sup>1</sup> This is actually a second Appeal. An earlier Appeal Brief (May 20, 2004), filed in response to an earlier Final Rejection (October 21, 2003), led to re-opened prosecution.

On October 18, 2006, the Examiner issued a paper responsive to the Reply Brief, comprising a paragraph of text under the heading “Reply Brief Noted.” In an Order returning the undocketed appeal to the Examiner (December 28, 2006), the Board concluded that this paper was significant to the point of constituting a Supplemental Examiner’s Answer, yet did not include the requisite approval by the TC Director. The Board ordered the Examiner to resubmit an action acknowledging receipt of the Reply Brief, either (a) with the requisite approval to submit a Supplemental Examiner’s Answer presenting arguments to new issues, or (b) without presenting any new argument.

On May 17, 2007, the Examiner filed another Answer – responsive to both the Appeal Brief (March 16, 2006) and the Reply Brief (July 17, 2006). This paper detailed a new ground of rejection (page 16) and included the signature of the TC Director.

Appellants objected to the introduction of a new ground of rejection in a Supplemental Answer (as contrary to 37 CFR 41.43(a)(2)), by filing a Motion to Strike on May 25, 2007.

The Examiner then filed two further Answers, one dated July 24, 2007, and the latter dated August 29, 2007. These appeared to be exact duplicates, except the latter included the signature of the TC Director. Again, both included a new ground of rejection.

On October 19, 2007, Appellants renewed their objection to the new ground of rejection in the July 24 and August 29, 2007, Answers, by a “Miscellaneous Incoming Letter.”

On May 6, 2009, the Board issued an Order returning the undocketed appeal to the Examiner. The Board found the August 27, 2007 Answer unacceptable because the Examiner combined a response to both the Appeal Brief and the Reply Brief in a hybrid document, whereas there are different rules governing each type of response. Additionally, the Board found the August 27, 2007 Answer unacceptable for including a new ground of rejection in a supplemental answer responding to a reply brief.

Accordingly, the Board ordered the application returned to the Examiner, for him to:

- (1) Take corrective action for resolving the unacceptable Answer by
  - a. Issuing a new Examiner's Answer which does not include a response to the Reply Brief; and
  - b. Properly responding to the Reply Brief in a separate action that complies with 37 CFR 41.43(a)(2) (i.e., does not include a new ground of rejection.); and
- (2) Officially respond to Appellant's communication filed October 19, 2007.

#### Discussion

The Examiner recently filed two papers, each entitled Examiner's Answer.

The first Examiner's Answer, mailed September 16, 2009, states that it is responsive to the Reply Brief (per Board Order (1)(b)), and also notes Appellants' communication filed October 19, 2007 (per Board order (2)). It is signed by the Examiner alone. (For some reason, PAIR identifies this paper as Notice - Defective Appeal Brief).

However, this paper responding to the Reply Brief does not, as is customary, simply acknowledge receipt and entry of the Reply Brief.<sup>2</sup> Rather, it includes several pages of argument.

Appellants respectfully submit that this September 16, 2009 paper is not effective as a (Supplemental) Answer because it was submitted without the approval of the TC Director, contrary to MPEP §§ 1207.05(I), 1208(II).

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<sup>2</sup> Actually, it does not expressly acknowledge entry of the Reply Brief.

The second Examiner's Answer, mailed October 6, 2009, states that it is responsive to both the Appeal Brief, and the Reply Brief.<sup>3</sup> In this later respect, it seems to violate the Board's order (1)(a), which required an Answer that does not include a response to the Reply Brief.

Substantively, however, the October 6, 2009 Examiner's Answer appears to be identical with the Examiner's original Answer, filed May 24, 2006.

Since Appellants already responded to the 2006 Answer by their July 16, 2006 Reply Brief, Appellants incorporate-by-reference that Reply Brief as their reply to the October 6, 2009, Examiner's Answer.

(Since filing the Reply Brief, Appellants submitted a copy of the Board's January 31, 2008, Decision on Appeal in Appeal 2007-4254, which concerns the meaning of the term "digital watermark," believing such Decision may be regarded as pertinent to the issues in the present application.)

Date: December 7, 2009

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Respectfully submitted,

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<sup>3</sup> Page 1, first paragraph.